

## **II. Remarks**

After entry of the amendment, claims 2-8, 10-17, 19-31, 33-40 and 104-106 and 117 are pending.

The specification and claims 2 and 23 have been amended to replace  $(C(R_e)(R_f))_k$ -T-Q by  $(C(R_o)(R_p))_k$ -T-Q. The definition of  $R_o$  and  $R_p$  are the same as that of  $R_e$  and  $R_f$  except that  $(C(R_e)(R_f))_k$ -T-Q has been deleted from the definition of  $R_o$  and  $R_p$ , and is supported by the specification at, for example, page 19, lines 18-32.

Claim 116 has been canceled and replaced with claim 117 and is supported by the specification at, for example, page 16, line 32 to page 17, line 5.

No issues of new matter should arise and entry of the amendment is respectfully requested.

### **Restriction Requirement**

In response to the Restriction Requirement of August 16, 2004, Applicants elected Examiner's Group II, with traverse. In the Office Action dated January 13, 2005, the Examiner made the restriction requirement final. In view thereof, Applicants are filing concurrently herewith a Petition from Requirement for Restriction Under 37 C.F.R. § 1.144.

Applicants respectfully request that the Petition be forwarded to the Group Director for timely consideration.

### **Rejection under 35 USC § 112, First Paragraph**

Claim 116 is rejected under 35 USC § 112, first paragraph, as lacking enablement..

Claim 116 has been canceled and replaced with claim 117 to include the names of the prostaglandins disclosed in the specification at page 16, line 32 to page 17, line 5. As stated by the Examiner in the Office Action "the specification while being enabling for the prostaglandins found on page 16, line 32 to page 17, line 5, does not reasonably provide enablement for all prostaglandins." Accordingly, Applicants have modified claim 116 (new claim 117) to conform to the Examiner's statement regarding enablement.

In view of the above, Applicants respectfully submit that the claim satisfies the requirement under 35 USC § 112, first paragraph, and respectfully request that the rejection under this provision be withdrawn.

**Rejection under 35 USC § 112, Second Paragraph**

Claims 2 and 3 are rejected under 35 USC § 112, second paragraph, as being indefinite.

The claims have been editorially amendment. Claims 2 and 23 have been amended to replace  $(C(R_e)(R_f))_k-T-Q$  by  $(C(R_o)(R_p))_k-T-Q$ . The definitions of  $R_o$  and  $R_p$  are the same as that of  $R_e$  and  $R_f$  except that " $(C(R_e)(R_f))_k-T-Q$ " has been deleted from the definition of  $R_o$  and  $R_p$  in response to the Examiner's rejection. The claims are supported by the specification at, for example, page 19, lines 18-32.

In view of the thereof, Applicants respectfully submit that the claims satisfy the requirement under 35 USC § 112, second paragraph, and respectfully request that the rejection under this provision be withdrawn.

**Rejection under 35 USC § 103(a)**

Claims 2 is rejected under 35 U.S.C. § 103(a) as being obvious over Del Soldato (WO 98/58910).

Applicants respectfully traverse the rejection and respectfully submit that the presently claimed invention is unobvious over the cited reference

Del Soldato was previously cited by the Patent Office in the Office Action dated November 25, 2004. In that Office Action, on page 3, lines 6-7, the Patent Office admitted that Del Soldato taught nitroprostaglandin compounds that are specifically excluded by the proviso in the claims. The compounds in claim 2 are structurally different from the compounds described by Del Soldato. There is no motivation or suggestion to make the compounds recited in claim 2 based on the compounds described by Del Soldato. The compounds in claim 2 are clearly not recited in Del Soldato and are structurally different from the compounds described in Del Soldato, and there is no motivation for one skilled in the art to make the compounds in claim 2 based on the teachings in Del Soldato.

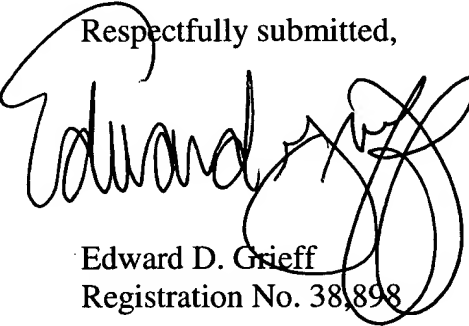
In view thereof, Applicants respectfully submit that the presently claimed invention is unobvious over the cited reference, and respectfully request that the rejection under 35 USC § 103 be withdrawn.

**Conclusion**

Applicants respectfully request reconsideration and allowance of claims 2-8, 10-17, 19-31, 33-40 and 104-106 and 117.

Examiner Stockton is encouraged to contact the undersigned at 202-942-8453 concerning any questions about the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edward D. Grief", with a large, stylized flourish at the end.

Edward D. Grief  
Registration No. 38,898

Date: April 11, 2005  
WILMER CUTLER PICKERING HALE AND DORR LLP  
1455 Pennsylvania Avenue, NW  
Washington, DC 20004  
Phone: 202-942-8453